

REMARKS

No claims are amended, canceled, or added with this response; as a result, claims 1-35 are now pending in this application.

Petition to Make Application Special

Applicants note that a Petition to Make Special was filed in the application on August 21, 2006. In addition, a Supplementary Preliminary Amendment, which included amendments to claims 10 and 19, was also filed in the application on August 21, 2006.

However, the Office Action in the Office Action Summary portion at checkbox 1 indicates that the Office Action is "Responsive to communication(s) filed on 14 December 2001." Further, there is no indication in the Office Action related to an acknowledgement of the Petition to Make Special or to the Supplementary Preliminary Amendment, both as filed August 21, 2006 in the application.

Applicants respectfully request a notification that the Petition to Make Special in the application has been received, and is accepted and is in force in the application. Applicants further respectfully request an acknowledgement that the Supplementary Preliminary Amendment filed August 21, 2006 in the application has been received, and that the amendments to the specification and to the claims as provided in the Supplementary Preliminary Amendment have been entered in the application.

Abstract Objections

The Abstract was objected to for containing a paragraph number in brackets at the beginning of the first text line. The Abstract has been amended to remove the paragraph number. Applicants submit that the objection to the Abstract has been overcome by this amendment, and respectfully request notification that the object has been overcome and that the objection is withdrawn.

Claim Objections

Claims 19 and 20 were objected to as being system claims dependent upon a method claim.

Applicants respectfully note that claim 19 was amended in the Supplemental Preliminary Amendment filed August 21, 2006 to depend upon system claim 18, and that claim 20 depends from claim 19. Applicants respectfully request notification that the amendment to claim 19 has been entered in the application, and that the objection to claims 19 and 20 has been overcome and is withdrawn.

§103 Rejection of the Claims

Claims 1-35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Esposito et al. (U.S. 6,587,838). Applicants respectfully traverse the rejection of claim 1-35.

For at least the reasons stated below, the Office Action fails to meet its burden for establishing a *prima facie* case of obviousness with respect to claims 1-35.

The Office Action fails to point out in Esposito et al., or any other evidence of record, a disclosure or suggestion of the subject matter included in claims 1-35. By way of illustration, independent claim 1 includes;

A method to facilitate a transaction by a network-based transaction facility, the method including:

receiving a request from a buyer accessing the network-based transaction facility to view offerings that are offered for sale via the network-based transaction facility;

responsive to the request, **retrieving information concerning a plurality of offerings, wherein the plurality of offerings include a first offering of a first transaction type and a second offering of a second transaction type;**

integrating information concerning the first and second offerings into a commingled list; and

causing the display of the commingled list to the buyer.

(Emphasis added).

Thus, independent claim 1 includes "retrieving information concerning a plurality of offerings . . . including a first offering of a first transaction type and a second offering of a

second transaction type." The Office Action fails to point out a disclosure or suggestion in Esposito et al. of this subject matter as required in independent claim 1.

In contrast to independent claim 1, Esposito et al. concerns "providing *real-time notification to vendors* of purchaser requirements in a heterogeneous network environment,"¹ wherein, "Users interact with plurality of client computers 102 in order to view information about products stored in product database 120."² (Emphasis added). However, there is no disclosure or suggestion in Esposito et al., and the Office Action fail to provide any other evidence of record, disclosing or suggesting, "retrieving information concerning a plurality of offerings, wherein the plurality of offerings include a first offering of a first transaction type and a second offering of a second transaction type," as required by independent claim 1.

In further illustration of subject matter included in independent claim 1 and not disclosed or suggested by Esposito et al., or by any other evidence of record, independent claim 1 also includes:

integrating information concerning the first and second offerings
into a commingled list; and
causing the display of the commingled list to the buyer.

The Office Action points to no disclosure or suggestion in Esposito et al., or in any other evidence of record, showing where the above elements of independent claim 1 are present in Esposito et al.

The description in Esposito et al. actually teaches away from "integrating information concerning the first and second offerings into a commingled list, and causing the display of the commingled list to the buyer," as included in independent claim 1. According to Esposito et al.:³

In a step 410, a user at one of the plurality of client computers is presented with a plurality of product options and services from which to make a selection. Then, in a step 412, responsive to user input indicating a particular product from a menu, the user is provided product information, including photographs, retrieved from the product database 120. In a step 414, a product selection and user specific information, including geographic information, is received from the user. In a step 416, a purchase request is transmitted to the vendor computer over the

¹ See Esposito et al. at column 1, line 32-34.

² See Esposito et al at column 3, lines 28-30.

³ See Esposito et al. at column 4, line 55 through column 5, line 15.

public packet switched communications network. Then, in a step 418, the purchase request is analyzed by the vendor computer to determine the product and proximity information of the user. Incoming information is examined to determine proximity information such as the area code or postal code of the user. This information determines which wireless service provider region and terminal accounts can be selected to receive vendor notification. In a step 420, based upon the proximity information, a plurality of vendors is selected from the product database 120, each of the vendors being in close proximity to the user. In a step 422, a wireless region and account information associated with each of the plurality of selected vendors is determined. Next, in a step 424, information about the user is recorded in the customer database 122. In a step 426, **vendor notification message 50 is transmitted to each of the selected vendors via the wireless network 108, based upon the wireless region and account information.** (Emphasis added).

Thus, Esposito et al. is concerned with transmitting *to vendor computers* the product selections of a user. This teaches away from the above quoted subject matter from independent claim 1 in which the commingled list is displayed to the buyer. The purpose of the vendor notification, according to the description in Esposito et al., is to see "if any of the one or more vendors can complete a purchase and sale transaction with the user, the vendor can contact the user directly."⁴ This description teaches away from the subject matter of independent claim 1, wherein in independent claim 1, "integrating information concerning the first and second offerings into a commingled list; and causing the **display of the commingled list to the buyer.**" (Emphasis added).

For at least the reasons stated above, Esposito et al. fails to disclose or suggest, and actually teaches away from, the subject matter included in independent claim 1, and so independent claim 1 is not obvious in view of Esposito et al.

In a further illustration of subject matter included in claims 1-35 and not disclosed or suggested by Esposito et al.:

⁴ See Esposito et all. at column 3, lines 44-46.

Independent claim 18 includes:

the transaction engine in response to the request, to retrieve information concerning a plurality of offerings, wherein the plurality of offerings include a first offering of a first transaction type and a second offering of a second transaction type;

the transaction engine to integrate information concerning the first and second offerings into a commingled list; and
a display engine to display the commingled list to the buyer.

Independent claim 35 includes:

retrieve information concerning a plurality of offerings, wherein the plurality of offerings include a first offering of a first transaction type and a second offering of a second transaction type;
integrate information concerning the first and second offerings into a commingled list; and
display engine to display the commingled list to the buyer.

For reasons analogous to those stated above with respect to independent claim 1, Esposito et al. fails to disclose or suggest all of the subject matter included in independent claims 18 and 35, and so independent claims 18 and 35 are not obvious in view of Esposito et al., or any other evidence of record.

Claims 2-17 and 19-34 depend from one of independent claims 1 and 18, and so include all of the subject matter included in the independent claim from which they depend, and more. For at least the reasons stated above with respect to independent claims 1 and 18, claims 2-17 and 19-34 are not obvious in view of Esposito et al., or any other evidence of record.

In an attempt to remedy the deficiencies of Esposito et al., the Office Action takes official notice, using more than a full page in the Office Action, of features included in claims 1-35 and admittedly not explicitly disclosed in Esposito et al.,⁵ including and not limited to taking official notice of the following:

⁵ See the Office Action on page 3 at line 13 through the end of page 4.

"2. the first transaction type implements a first price-setting process, and the second transaction type implements a second price-setting process;⁶

...
11. causing the display of the commingled list to the buyer includes filtering the commingled list into offerings of a specific transaction type only;⁷

...
13. the specific transaction types in an auction type transaction, the method including causing the display of offerings of the auction transaction type only, wherein the offering of the auction transaction type are sorted according to end time of a respective auction.⁸"

Applicants object to the taking of official notice in a single reference obviousness rejection, and pursuant to M.P.E.P. § 2144.03, Applicants traverse each of the assertions of official notice. In making the rejections of claims 1-35 based on Esposito et al. and taking official notice, the Office Action merely states, ". . . it was well known at the time of Applicant's invention wherein: . . .,"⁹ and then proceeds to merely provide a recitation of the elements included in several of claims 1-35, for example but not limited to a recitation of items 2, 11, and 13 as quoted above from the Office Action. Thus, the Office Action is reconstructing the claimed invention included in claims 1-35 by simply using the language of claims 1-35 as a statement of what the Office Action believes to be "well known at the time of Applicant's invention." This amounts to no more than an impermissible use of hindsight in an attempt to fill the deficiencies in Esposito et al. in rejecting claims 1-35. Such a hindsight reconstruction of the subject matter of claims 1-35 fails to meet the burden required of the Office Action in stating a *prima facie* case of obviousness in rejecting claims 1-35.

For at least the reasons stated above, the Office Action fails to meet its burden for establishing a *prima facie* case of obviousness with respect to claims 1-35, and Applicants respectfully request reconsideration and withdrawal of the rejection, and allowance of claims 1-35.

⁶ See the Office Action at page 3, lines 21-22.

⁷ See the Office Action at page 4, lines 5-7.

⁸ See the Office Action at page 4, lines 9-12.

⁹ See the Office Action at page 3, lines 20-21.

Reservation of Rights

In the interest of clarity and brevity, Applicants may not have addressed every assertion made in the Office Action. Applicants' silence regarding any such assertion does not constitute any admission or acquiescence. Applicants reserve all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicants do not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicants timely object to such reliance on Official Notice, and reserve all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicants reserve all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney at 612-371-2132 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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By their Representatives,

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Date AUGUST 9/2007

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 9 day of August 2007.

Name Pete v Peabody

Signature Pete D